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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,217	01/21/2004	Franky Bru	ESKO-037	2194
21921	7590	04/02/2008		
DOV ROSENFELD 5507 COLLEGE AVE SUITE 2 OAKLAND, CA 94618			EXAMINER DHINGRA, PAWANDEEP	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 04/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,217

Applicant(s)

BRU, FRANKY

Examiner

PAWANDEEP S. DHINGRA

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12-20 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 7/26/2006, 7/14/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-7, and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-7, and 16-20 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

In Claims 1-7, and 16-20, while defining a computer implemented method or process does not define a "computer-readable medium" and is thus non-statutory for that reasons. A computer implemented method can range from paper on which the method/program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the method/program on "computer-readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure

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and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a).

Examiner Notes

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-10, and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dimensional Impressions Score! X, © 2002 Dimensional CAD/CAM Systems. Score! X, an Artwork Systems Inc. company, Bristol,

PA. Available online at <http://www.score-x.com/index.htm>;
<http://www.score-x.com/flow.htm>; <http://www.score-x.com/features.htm>.

Re claim 1, Score! X discloses a computer-implemented method of designing graphics to be printed on a planar substrate that will be cut and folded to yield a three-dimensional carton having outer surface regions that will be printed with the graphics so designed (see <http://www.score-x.com/index.htm>, page 1; <http://www.score-x.com/flow.htm>, pages 1-2, and <http://www.score-x.com/features.htm>), the method comprising: (a) accepting structural information relating to said carton (see <http://www.score-x.com/flow.htm>, page 1, paragraph 1); (b) designing graphics to cover surface regions of said carton to be printed with graphics (see <http://www.score-x.com/flow.htm> - page 1, paragraph 2-3; <http://www.score-x.com/features.htm> - design library, fully parametric designs, graphic flexibility, and revolutionary 3-D sections); (c) superimposing graphics designed at step (b) on a computer-generated image of relevant regions of said planar substrate to be printed with graphics (see <http://www.score-x.com/flow.htm> - page 1, paragraph 2-3; <http://www.score-x.com/features.htm> - design library, fully parametric designs, graphic flexibility and revolutionary 3-D sections); (d) manipulating, as required, said graphics designed at step (b) to cover relevant said regions of each said surface, as viewed on said computer-generated image (see <http://www.score-x.com/flow.htm> - page 2, paragraph 1-2; <http://www.score-x.com/features.htm> - design library, fully parametric designs, graphic flexibility and revolutionary 3-D sections); (e) creating a three-

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dimensional computer-generated image of said carton, said image including graphics designed at step (b) and, if required, manipulated at step (d) (see <http://www.score-x.com/flow.htm> - pages 1-2; <http://www.score-x.com/features.htm> - design library, fully parametric designs, graphic flexibility and revolutionary 3-D sections); (f) visually confirming from said computer-generated image created at step (e) acceptability of graphics covering relevant said regions, and modifying, if required, said graphics (see <http://www.score-x.com/flow.htm> - pages 1-2; <http://www.score-x.com/features.htm> - design library, fully parametric designs, graphic flexibility and revolutionary 3-D sections); and (g) outputting a computer-readable file containing designed said graphics whose acceptability was confirmed at step (f) (see <http://www.score-x.com/flow.htm> - page 2, paragraphs 2-3, and <http://www.score-x.com/features.htm> - revolutionary 3-D, powerful translators sections).

Re claim 2, Score! X further teaches wherein at step (a), said structural information includes at least one of (i) a pattern showing cuts to be made on said planar substrate to define at least one of a panel and a flap, (ii) information defining where at least one of a panel and a flap are to be folded through a fold angle, and (iii) information relating to composition of said substrate (see <http://www.score-x.com/flow.htm> - pages 1-2; <http://www.score-x.com/features.htm> - design library, fully parametric designs, and revolutionary 3-D sections).

Re claim 3, Score! X further teaches including generating at least one clipping mask to avoid printing on a surface of said carton that is not visible when fabrication of said carton is complete (see <http://www.score-x.com/flow.htm> - pages 1-2; <http://www.score-x.com/features.htm> - fully parametric designs, revolutionary 3-D section, note that user can set parameters and view the exact replica of the carton which is going to be printed).

Re claim 5, Score! X further teaches wherein manipulating at step (d) includes at least one of (i) rotation, (ii) scaling, (iii) copying, (iv) cutting, and (v) pasting (see <http://www.score-x.com/flow.htm> - pages 1-2; <http://www.score-x.com/features.htm> - design library, fully parametric designs, and revolutionary 3-D sections).

Re claim 6, Score! X further teaches providing said computer-readable file output at (g) as input to a carton fabrication system (see <http://www.score-x.com/flow.htm> - page 2, paragraph 3, and <http://www.score-x.com/features.htm> - powerful translators section, note that the computer readable file can be emailed or saved on a disk, and using email or disk as an input to a any kind of fabrication system is well-known in the art).

Re claim 7, Score! X further teaches wherein said graphics are designed for printing on a carton having at least five surfaces (see <http://www.score-x.com/flow.htm> - pages 1-2; <http://www.score-x.com/features.htm> - design library, fully parametric designs, and revolutionary 3-D sections).

Re Claims 8-10, and 12-13, claims 8-10, and 12-13 recite identical features, as claims 1-3, and 5-6, except claims 8-10, and 12-13 are an apparatus claims. Thus, arguments made for claims 1-3, and 5-6 are applicable for claims 8-10, and 12-13.

Re Claims 14-15, claims 14-15 are essentially similar to claims 1 & 6 and are rejected on the same grounds.

Re claim 16, steps (a)-(g) of claim 16 are essentially similar to claim 1 and are rejected on the same grounds. Step (h) recites using said computer-readable file output at step (g) to control at least in part printing of said graphics upon at least some surface regions of said planar substrate (see Score! X, <http://www.score-x.com/flow.htm> - pages 1-2; and <http://www.score-x.com/features.htm> - design library, fully parametric designs, and revolutionary 3-D sections).

Re claims 17 is essentially similar to claim 16 and is rejected on the same grounds.

Re claim 18, Score! X fails to teach wherein said substrate is printed with said graphics before said substrate is cut.

However, Official Notice is taken to note that ability to print the substrate with said graphics before said substrate is cut is notoriously well known and commonly used in the art. It would have been obvious to one with ordinary skill in the art to input the output file of Score! X to a carton fabrication system, which

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prints the substrate with said graphics before cutting said substrate for the benefit of providing a substrate with precisely printing as desired by the user. Also note that applicant's disclosure discloses in paragraph 31 that *"Carton fabrication system 300 benefits from aspects of the present invention, but need not be considered part of aspects of the present invention"*. Furthermore, printing the substrate with said graphics before said substrate is cut is also notoriously well known and commonly used in the art of carton fabrication system.

Re claims 19-20 are essentially similar and recite same elements as claims 2 & 3 and are rejected on the same grounds.

Allowable Subject Matter

Regarding claims 4 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose, teach, or suggest the claimed inventions of (in combination with all other limitations in the claims), identifying regions of graphics to be printed on said carton that are likely to experience printing ink bleeding and compensating for such bleeding in laying out said regions of said graphics as set forth in claims 4 & 11.

Note

The preamble of claims 1, 8, 14, 16, and 17 recites intended use (i.e. "*printed on a planar substrate that will be cut and folded to yield a three-dimensional carton having outer surface regions that will be printed with the graphics so designed*") and "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997)." See MPEP 2111.02 II. Hence, the preamble may or may not import patentable weight to the claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAWANDEEP S. DHINGRA whose telephone number is (571)270-1231. The examiner can normally be reached on M-F, 9:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. D./

Examiner, Art Unit 2625

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625